REMARKS

Claims 55, 57-64 and 71-79 are currently pending in this application. Claim 56 has been canceled without prejudice to Applicants' right to pursue subject matter it recited in one or more continuation, divisional or continuation-in-part applications. Claims 55 and 71 have been amended as shown above. New claims 72-29 have been added. Support for the amendments and the new claims can be found in the specification as filed (*e.g.*, page 5, lines 19-22). The title has been amended to more accurately reflect what is claimed. No new matter has been added.

I. The Rejection Under 35 U.S.C. §112, ¶ 1, Should Be Withdrawn

On page 2 of the Office Action, the Examiner maintains the rejection of claims 55-56 and 71 under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable one of ordinary skill in the art to treat, manage, or prevent apnea or apnea disorders. In particular, it is alleged that "[d]ue to the lack of pharmacological methods of treating sleep apnea, there is a high level of unpredictability associated with a method of treating, managing and preventing apnea and apnea disorders." (Office Action, page 2). It is further alleged that "it would take undue experimentation to determine which apnea disorders (+) norcisapride would be useful to treat." (*Id.*).

The claims pending in this application have been amended to recite the treatment, prevention or management of sleep apnea or sleep induced apnea. Consequently, this rejection may now be moot. Applicants believe, however, that they are entitled to the full scope of the invention as originally claimed. For this reason, the rejection is traversed for the following reasons.

It is well established that:

> a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of §112 *unless* there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Fiers v. Revel, 984 F.2d 1164, 1171-72 (Fed. Cir. 1993) (emphasis in original). Thus, "[i]n examining a patent application, the PTO is required to assume that the specification complies with the enablement provision of Section 112 unless it has 'acceptable *evidence or reasoning*' to suggest otherwise." *Gould v. Mossinghoff*, 229 USPQ 1, 13-14 (D. D.C.

1985), *aff'd in part, vacated in part, and remanded sub nom., Gould v. Quigg*, 822 F.2d 1074 (Fed. Cir. 1987) (quoting *In re Marzocchi*, 349 F.2d 220, 223-24 (C.C.P.A. 1971))(emphasis added). Moreover, "the inventor need not disclose or explain how or why the invention works." *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565 (Fed. Cir. 1983).

On page 2 of the Office Action, it is alleged that apnea is not affected by the basal tone of the vagus nerve and that there is a "lack of pharmacological methods of treating sleep apnea." Applicants respectfully submit that these allegations do not provide a foundation upon which an enablement rejection can be properly based. In view of the fact that Applicants need not disclose in any detail how or why the claimed invention works, the Examiner's assertions simply do not provide any evidence or reasoning why the claimed invention would not work. *See Gould*, 229 USPQ at 14 ("the PTO had no proper evidentiary basis for questioning the adequacy of [the] disclosure."). For this reason alone, Applicants respectfully request that the rejection be withdrawn.

Even if the one were to assume, for the sake of argument, that the allegations made in the Office Action can support the enablement rejection, additional reasons exist why it should be withdrawn. For example, a patent claim does not lack enablement simply because it may require some experimentation: "[t]hat some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is 'undue.'" *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991). Some factors that may--but need not[1]--be considered in determining whether experimentation is undue include the predictability of the art. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). In *Wands*, the Court of Appeals for the Federal Circuit held that claims directed to immunoassay methods *were* enabled even though in order to practice the claimed invention, one would have to screen "hybridomas to determine which ones secrete antibody with desired characteristics." This was because "[p]ractitioners of this art are prepared to screen negative hybridomas in order to find one that makes the desired antibody." *Id.* at 740.

As in *Wands*, the Examiner here is objecting to what is basically a screening step. Yet here, the screening is not nearly as complex, as the claimed invention is directed to the use of a specific, readily obtainable compound, for which routes of administration and

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[1] *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1230 (Fed. Cir. 1991), *cert. denied*, 502 U.S. 856 (1991) ("it is not necessary that a court review all the *Wands* factors to find a disclosure enabling. They are illustrative, not mandatory.").

amounts are set forth in the specification.[2] Moreover, the determination by a physician as to whether (+) norcisapride is effective in treating a particular type of apnea in a given patient is a type of determination that is *always* made by physicians for *every* pharmaceutical. Indeed, the determination is a *routine* one that every physician is prepared to make, and which requires little or no effort. Therefore, Applicants respectfully submit that one reasonably skilled in the art could make or use the invention as originally claimed without undue experimentation.

In sum, Applicants respectfully submit that the rejection under § 112, first paragraph, should be withdrawn, since it is based on insufficient evidence and reasoning. However, even if the reasoning provided in the Office Action were sufficient, Applicants respectfully request that the rejection be withdrawn, since the originally claimed invention can be readily used by those of ordinary skill in the art without undue experimentation.

II. The Rejection Under 35 U.S.C. §112, ¶ 2, Should Be Withdrawn

On pages 2-3 of the Office Action, the Examiner maintains the rejection of claims 55-64 and 71 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicants respectfully disagree for reasons set forth in prior responses. Applicants submit that the rejection should be withdrawn for the additional reason that the claims are now directed to the treatment, prevention or management of sleep apnea or sleep induced apnea, not to apnea or apnea disorders in general.

III. The Rejection Under 35 U.S.C. §103 Should Be Withdrawn

On page 3 of the Office Action, the rejection of claims 55-64 and 71 under 35 U.S.C. § 103 is maintained. In particular, it is alleged that the invention would have been obvious over U.S. Patent 5,739,151 to McCullough *et al.* ("McCullough") in combination with Skinner, *Tex. Medic.*, 94(9):57-58 (1998) ("Skinner"). Applicants respectfully disagree.

As discussed in previous responses, three criteria must be met in order to establish a *prima facie* case of obviousness. *Manual of Patent Examining Procedure*, February

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[2] As discussed in Applicants' response of March 20, 2003, the specification provides information concerning patients who can be treated using methods of the invention, dosing regimens, dosage ranges, and routes of administration. *See, e.g.,* Specification at page 11, lines 7-26.

2003 ("MPEP") § 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one of skill in the art to combine the references. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. *Id.* The suggestion or motivation must be found in the prior art, not in the applicant's invention. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Moreover, the teaching or suggestion to look at particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor must also be within the prior art, or within the general knowledge of a person of ordinary skill in the art. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Applicants respectfully submit that the requirements necessary to establish a *prima facie* case of obviousness have not been met. First, one of ordinary skill, prior to this invention, would not have been motivated to combine the references. Second, even if one were to combine the references, the resulting combination would not have provided those of ordinary skill in the art with a reasonable expectation that the claimed invention would work. Finally, the combination does not teach or suggest all of the limitations recited by the pending claims. Each of these deficiencies is considered below.

McCullough focuses on pharmaceutical compositions comprising (+) norcisapride and its use to treat a wide range of diseases, one of which is gastromotility dysfunction. (McCullough, col. 7, lines 17-28). In contrast, Skinner discloses the treatment of a single case of antral ulcer accompanied by gastroesophageal reflux (GER), and aims to direct physicians, when assessing the etiology of waking apnea in full-term infants, to consider GER and gastric ulcer as potential causes. (Skinner, page 58). Because of the references' disparate aims, one of ordinary skill in the art would have had no motivation to combine them prior to this invention. Indeed, the fact that they are combined in the Office Action suggests the use of impermissible hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (holding that it is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a blueprint). Consequently, Applicants respectfully request that the rejection under § 103 be withdrawn.

Even if one assumed a motivation to combine McCullough and Skinner did exist prior to this invention, their combination would not have provided those of ordinary skill in the art with any expectation of success. For example, it was well known that waking apnea in infants can be a symptom associated with a number of underlying conditions,

including infection, shock, metabolic disorders, neonatal abstinence syndrome, intracranial pathology, and GER. (Skinner, page 57, col. 1). Consequently, the combination of McCullough and Skinner would not have suggested to one of ordinary skill that (+) norcisapride would be effective in the treatment of any particular patient suffering from apnea, much less a patient suffering from sleep apnea or sleep induced apnea. Indeed, the specific type of apnea upon which Skinner focuses "is seen predominantly in the awake state." (*Id.*, col. 2) (emphasis added). Neither McCullough nor Skinner suggests any connection between GER and sleep or sleep induced apnea. Moreover, the specific case of apnea disclosed by Skinner was treated using a specific combination of drugs—ranitidine and cisapride. (*Id.*). Thus, even if one were to combine McCullough and Skinner, the combination would not have provided those of ordinary skill in the art with any expectation that sleep apnea or sleep induced apnea can be successfully treated, prevented or managed using (+) norcisapride.

Finally, the combination of McCullough and Skinner does not disclose or suggest all of the limitations of the pending claims. For example, the combination does not disclose the treatment of sleep apnea or sleep induced apnea. Indeed, Skinner focuses on the treatment of a condition that is not associated with sleep. (*Id.*).

In sum, Applicants respectfully submit that none of the three criteria necessary to establish a *prima facie* case of obviousness have been met, and request that the rejection under § 103 be withdrawn.

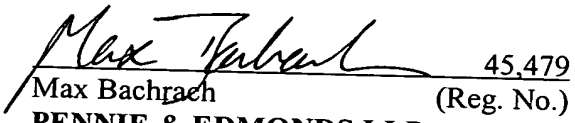
IV. Conclusion

Applicants respectfully submit that this case is in condition for allowance for reasons that include, but are not limited to, those discussed herein as well as those presented in prior responses.

No fee is believed due for this submission. However, if any fee is due, please charge such fee to Pennie & Edmonds LLP Deposit Account No.16-1150.

Respectfully submitted,

Date: November 21, 2003



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Enclosure